

REMARKS

I. Introduction

In response to the pending Office Action, Applicants have amended claims 1, 4 and 5 and cancelled claims 2 and 3 to further clarify the intended subject matter of the invention and to overcome objections for improper antecedent basis. The limitations of claim 2 were incorporated into claim 1. Support for the amendment to claim 1 can be found, for example, on page 9, lines 29-33 and page 16, lines 17-23 of the specification. In addition, Fig. 7 has been amended to indicate that it is Prior Art. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art.

II. The Rejection Of Claims 1-5 Under 35 U.S.C. § 103

Claims 1-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art in view of Hayashi (U.S. Pat. No. 6,359,235). Applicants respectfully traverse this rejection for at least the following reasons.

Claim 1 recites, in-part, a printed wiring board comprising...an auxiliary lead which is provided on the insulating board while *the auxiliary lead is not in electrical contact with the signal transmitting lead*; and an *electromagnetic shielding layer made of a magnetic material having magnetic loss which covers at least a part of the auxiliary lead*, wherein a signal is not carried to the auxiliary lead.

In contrast to the claimed invention, Jones discloses that the auxiliary lead 26 is connected to leads 36 via bonding pads 18, the semiconductor chip 15 and bonding wires 40, 42 and 44. In addition, the second electrically conductive layer 28 is connected to leads 36 (see,

Fig. 2.). However, claim 1 of the present invention recites that the auxiliary lead is NOT in electrical contact with the signal transmitting lead. Thus, Jones fails to disclose an auxiliary lead which is provided on the insulating board where *the auxiliary lead is not in electrical contact with the signal transmitting lead.*

Furthermore, the Examiner alleges that Jones teaches an electromagnetic shielding layer 28 which covers at least a part of the auxiliary lead 26 (col. 5, lines 54-57). However, numeral 28 of Jones is the electrically conductive metal plate, not the electromagnetic shielding layer. Thus, Jones does not disclose an electromagnetic shielding layer made of a magnetic material having magnetic loss which covers at least a part of the auxiliary lead.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA1974). As neither the APA, Hayashi and Jones fail to teach or suggest that the auxiliary lead is not in electrical contact with the signal transmitting lead and that an electromagnetic shielding layer made of a magnetic material having magnetic loss covers at least a part of the auxiliary lead, it is submitted that the APA, Hayashi and Jones et al., either alone or together do not render claim 1 obvious. Accordingly, it is respectfully requested that the § 103 rejection of claim 1, and any pending claims dependent thereon be withdrawn.

III. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons

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set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

IV. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication of which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS:

Please amend Fig. 7 as indicated on the enclosed copy thereof. Fig. 7 has been amended to indicated its status as Prior Art.